REMARKS

This is in response to the FINAL Official Action currently outstanding with regard to the present application.

Claims 1-20 were pending in this application at the time of the issuance of the currently outstanding FINAL Official Action. Applicant respectfully requests that the foregoing Amendments to the claims of this application be entered so as to place this application in condition for allowance, or at least in better form for Appeal, pursuant to 37 CFR 1.116. More particularly, Applicant respectfully requests that Claims 1, 4, 6, 10, 14 and 19 be amended as set forth above, and that Claims 2-3, 5, 7, 9, 11, 13 and 15 be canceled, without prejudice. Applicant does not seek the addition or the withdrawal of any claims by this submission. Accordingly, in the event that the Examiner grants entry to the foregoing Amendment, Claims 1, 4, 6, 8, 10, 12, 14, and 16-20 as amended above will constitute the Claims under active prosecution in this application.

The claims of this application as they will stand in the event that the Examiner grants entry to this Amendment are reproduced above including appropriate status identifiers and showing the Amendments sought as required by the Rules.

More particularly, in the currently outstanding Official Action the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and confirmed the receipt of the required copies of the priority documents by the United States Patent and Trademark Office;

2. Failed to provide Applicant with an indication concerning the acceptability of the drawings as filed with this application on 22 November 2000, however; Applicant notes that the drawing were previously indicated to be accepted in the previous Office Action dated 3 June 2005.

3. Acknowledged his consideration of the Information Disclosure Statement filed in this application on 6 January 2005 by providing the Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed by the Examiner to confirm his consideration of the art listed therein;

4. Rejected Claims 1 and 19 under 35 USC §103(a) as being unpatentable over Bloomberg (US Patent 5,181,255) in view of Mita et al (US Patent 5,060,280);

5. Rejected Claims 2-13 and 17-18 and 20 under 35 USC §103(a) as being unpatentable over· Bloomberg (US Patent 5,181,255) in view of Mita et al (US Patent 5,060,280) and further in view of Ohki et al (US Patent 6,636,647); and

6. Rejected Claims 14-16 under 35 USC §103(a) as being unpatentable over Bloomberg (US Patent 5,181,255) in view of Mita et al (US Patent 5,060,280) and further in view of Ohki et al (US Patent 6,636,647) and yet further in view of Hart et al (US Patent 5,694,494);

No further comment regarding items 1-3 above is deemed to be required in these Remarks.

With respect to items 4-6, Applicant respectfully notes that by the foregoing Amendment, it is proposed (i) that Claim 2 be combined with Claim 1, (ii) that Claims 2, 3, 5, 7, 9, 11, 13 and 15 that were directly or indirectly dependent upon Claim 1 prior to the foregoing Amendment be canceled, without prejudice, (iii) that Claim 19 be amended so as to depend from amended Claim 1, and (iv) that the remaining claims that were previously directly or indirectly dependent upon Claim 2 be amended so as to depend either directly or indirectly from amended Claim 1. Applicant respectfully submits that the entry of the foregoing amendments would place this application in condition for allowance, or at least in better form for Appeal as required by 37 C.F.R. 1.116.

In support of this assertion, Applicant respectfully notes that the Examiner has specifically admitted that "(n)either Bloomberg nor Mita quite teach: wherein the control portion reads a layout code previously printed on the form by the reading portion, and reads mask data of the layout corresponding to the layout code from the storage portion" as herein claimed. The Examiner suggests, however, that the Ohki et al reference discloses this feature of the present invention, and further that, therefore, the present invention as claimed in Claim 2 (now combined with Claim 1) is obvious within the meaning of 35 USC 103(a) over the combination of the Bloomberg, the Mita and the Ohki references. Applicant respectfully disagrees.

As Applicant has previously asserted, the Ohki et al reference is inappropriate as a reference against the present application. Thus, although the Ohki et al reference describes extracting image features using a mask image, it must be understood that the Ohki et al reference does not accomplish this in the manner herein disclosed and claimed. In Ohki et al, the operator selects two images and those images are superimposed upon on another. At that point, the operator designates a "superimpose area" using an input device, the so-called superimpose area defining the area of the superimposed images that is not deleted by the "mask" (see, Ohki et al at Fig. 2C and 5A-6C). Accordingly, the Ohki et al reference is characterized in that by superimposing a mask image on an area where two images overlap one another the features of the two images located in the superimposing area (i.e., an area that is determined by the operator who is going to operate the apparatus, see, Ohki, et al at Col. 8, lines 27-30), the features of the two images in the superimposing area are extracted, and thereafter are merged in a natural looking manner. Accordingly, in Ohki et al there is no distinct means whereby the images and the mask are matched with one another based upon pre-selected criteria. Rather, in Ohki et al the configuration of the mask is the subject of a definition of a so-called "superimpose area" by the operator at the time of use.

In other words, the Ohki et al reference allows the operator to select two images, superimpose those images so as to form a composite image, define a "superimpose area", mask out the area of the superimposed images not within the "superimpose area", and thereafter alter the area of the superimposed images within the superimpose area defined at the time of use so as to create a natural appearing final image. (see Ohki, et al. at Col. 8, line 14, et seq.)

Therefore, it will be noted that the Examiner's reliance upon the disclosure of the Ohki et al reference found at Column 7, lines 38-51, as supporting his assertion that the Ohki et al reference discloses "The reading apparatus of claim 1, wherein the control portion reads a layout code previously printed on the form by the reading portion, and reads mask data of the layout corresponding to the layout code from a storage portion" is misplaced. The portion of the Ohki et al reference relied upon by the Examiner simply relates to a data merging apparatus as shown in Fig. 1 of the Ohki et al reference including the input device 106 used by the operator in designating the images to be superimposed and the so-called "superimpose area" (see, Ohki, et al at Col. 8, lines 27-30).

More specifically, the data merging apparatus 100 of the Ohki et al reference is indicated to include a processing circuit 101 for executing a processing program, a program memory 102 for storing a processing program, a data memory 103 for storing data to be processed, a frame memory 104 for storing image data to be merged and image data already merged, and image display device 105 for displaying image data stored in the frame memory 104, an input device 106 such as a mouse or keyboard (used by the operator in selecting the images to be processed and in defining the superimposing area), an external storage device 107, for storing the image data to be merged, a communication interface (I/F) 108 connected to a communication line for exchanging information with external terminals, and a bus 109 connected to the circuits for transferring programs and data. However, nothing in this description of the data merging apparatus of Ohki et al in any way discloses or suggests a control portion that reads a layout previously printed on a form by a reading portion, and in response thereto reads mask data of a layout corresponding to the layout code pre-stored in the storage portion. Quite the contrary, as indicated above, the Ohki et al reference does not in any way pre-store masks to be associated with particular content of images to be processed. In fact, the image to be processed is not determined until the operator selects two images to be superimposed on one another, and the configuration of the mask is not determined until the operator selects it manually at the time of use.

In contrast, the present invention is characterized in that by superimposing a pre-stored mask image on one image read from a form in which data has been entered by handwriting or the like, the form being matched to the pre-stored mask image by a mark of some type, the handwritten part may be extracted. In this regard it will be understood that the simple fact is that none of the references relied upon by the Examiner teaches, discloses or suggests the marks (i.e., layout code, printing magnification or detection marks) claimed in this application that are used in the system to associate particular masks with particular images. Specifically, none of the cited references teaches, discloses or suggests such marks previously printed on a form that are used to determine which of a plurality of stored masks is to be superimposed onto a read-out image, and/or in the control of such operational parameters as the relative position and/or inclination of the read-out image to the mask that is to be utilized. Still further, with the constitution of amended claims 1 and 19, since the mask data of the layout corresponding to the layout code which was previously printed on the form read out by the reading portion is read from the storage portion, the inherent consequence is that even when a plurality of form layouts are prepared, the entered data still can surely be extracted in accordance by the selection of the corresponding appropriate mask from memory. (See, present specification at page 5, line 21, to page 6, line 1) Applicant respectfully submits that this construction and mode of operation is clearly distinct, and not suggested to one skilled in the art by Ohki, et al alone or in any combination with the other cited references.

Furthermore, the detection marks previously printed on the forms as described in Claims 4, 6 and 8 and the magnification governed by the marks previously printed on the forms described in Claims 10 and 12 are not taught, disclosed or suggested in the portions of any of the references cited and relied upon by the Examiner. Accordingly, even if the Bloomberg, Mita and Ohki references were to be considered by one skilled in the art at the time that the present invention was made at the same time, Applicant respectfully submits that such a person would not arrive at the concepts of correcting position and inclination of image data using a detection mark; adjusting the size of image data and mask data by using a detection mark; and reading out mask data of a size corresponding to a print magnification by using the print magnification itself. Moreover, the Ohki description relied upon by the Examiner totally fails to teach, disclose or suggest that the mask data should be data of print areas of a layout code and detection marks as specified in Claims 17 and 18 above.

In this regard again, Applicant respectfully submits that it must be recognized that the Ohki et al reference does not contemplate working with pre-defined images and pre-defined masks. Instead, in Ohki, et al the operator selects the images, the images are superimposed and the operator manually selects a "superimpose area" that defines the portion of the superimposed images that will not be blocked out by the mask.

In view of the foregoing, Applicant again respectfully submits that when the appropriate criteria for the establishment of a *prima facie* case of obviousness are applied to the Ohki reference, it will be readily understood that a person of ordinary skill in the art at the time that the present invention was made would not have been lead to the presently claimed invention from a consideration of the Ohki construction either alone or in combination with Bloomberg and/or Mita. Rather, it is only through a consideration of the Applicant's specification that the present invention becomes apparent to one skilled in the art, i.e., it is only via improper hindsight reasoning that one of ordinary skill in the art would reach the present invention with or without the teachings of the Bloomberg and/or Mita and/or Ohki references before him.

It will be recalled in the above regard that the criteria for the establishment of a *prima facie* case of unpatentability under 35 USC 103(a) are set forth in the MPEP as follows:

> To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*)

Applicant respectfully submits that the foregoing criteria are not satisfied in the currently outstanding Official Action in this case.
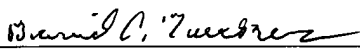
Finally, it will be recognized that since Ohki aims at merging image data in a natural looking manner, it is considered to be impossible in the case of Ohki that the printing means as disclosed in present Claim 19 of this application would be used for printing out the data after superimposing the entered data extracted and the layout data stored previously.

For each and all of the foregoing reasons, entry of the foregoing Amendment pursuant to the terms of 37 CFR 1.116, reconsideration and allowance of all of the claims present in this application after the entry of this Amendment in response to this communication are respectfully requested.

Applicant also believes that additional fees beyond those submitted herewith are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. 04-1105, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: February 27, 2006

David A. Tucker
SIGNATURE OF PRACTITIONER

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